



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Peters et al.

Appl. No. 10/051,311

Filed: January 22, 2002

For: **Method for Identifying
Compounds Modulating Sister
Chromatid Separation**

Confirmation No. 4782

Art Unit: 1652

Examiner: Christian L. Fronda

Atty. Docket: 0652.2290001/JUK/Y-W

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Reply To Restriction Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated **June 26, 2003**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-6. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

Group I (claims 1-6) is drawn to a method of identifying a compound that modulates sister chromatid separation. Group II (claims 7-9) is drawn to a peptide that can be used to develop compounds that modulate sister chromatid separation. Group III (claim 10) is drawn to a compound identified by the method in Group I that modulates sister chromatid separation. All three groups are directed toward the identification of compounds or individual compounds that modulate sister chromatid separation. As a result, a prior art

search for Group I would encompass Group II and Group III rather than requiring separate searches as the Examiner states.

Furthermore, even where two patentably distinct inventions appear in a single application, restrictions remain improper unless the Examiner can show that the search and examination of both groups would entail a serious burden. *See* M.P.E.P. § 803.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Judith U. Kim

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Date: July 28, 2003

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July 28, 2003

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Art Unit 1652

Re: U.S. Utility Patent Application
Appl. No. 10/051,311; Filed: January 22, 2002

For: **Method for Identifying Compounds Modulating Sister Chromatid Separation**

Inventors: Peters *et al.*

Our Ref: 0652.2290001/JUK/Y-W

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Transmitted herewith for appropriate action are the following documents:

1. Reply to Restriction Requirement; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Judith U. Kim
Attorney for Applicants
Registration No. 40,679

JUK/Y-W:cpn
Enclosures

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